

REMARKS

The present request is submitted in response to the final Office Action dated November 7, 2006, which set a three-month period for response, making this amendment due by February 7, 2007.

Claims 3-6, 8, 10, and 12 are pending in this application.

In the final Office Action, claims 3-5, 10, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,672,104 to Okada on the same grounds as stated in the Office Action dated February 17, 2006. Claims 6 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of ASM Handbook, Volume 14, on the same grounds as stated in the Office Action of February 17, 2006.

The Applicants again must respectfully disagree with the stated grounds for rejection and request withdrawal of the final rejection.

The text passage cited by the Examiner, column 11, lines 39-50, does not disclose the features introduced into claims 4 and 12 in the last amendment, specifically, that ***no forced cooling is employed and a martensitic structure is formed***. In that text citation, it is stated unambiguously that the air-cooling is to take place before the hardening. Since the steels used in this regard are NOT air-hardening steels, ***no*** martensite is formed. Rather, the martensite formation takes place only at the actual hardening process, which presents a considerably higher cooling velocity.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01. Please note also that the modification proposed by the Examiner would change the principle of operation of the prior art, so that also for this reason the references are not sufficient to render the claims prima facie obvious (see the last paragraph of the aforementioned MPEP section 2143.01).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestions supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. ***ACS Hosp. Sys., Inc. v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

For the reasons set forth above, the Applicants respectfully submit that claims 3-5, 8, 10, and 12 are patentable over the cited art. The Applicants further request withdrawal of the final rejection and reconsideration of the claims as previously presented.

In light of the foregoing arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss

appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

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